

## REMARKS

Applicants respectfully request reconsideration of this application as amended.

### *Office Action Rejections Summary*

Claims 1, 9 and 13 have been rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, 9 and 12 have been rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter.

Claims 5-8 have been rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,148,329 of Meyer ("Meyer") in view of U.S. Patent No. 5,586,304 of Stupek Jr. et al. ("Stupek").

Claims 1-4 and 9-17 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Meyer in view of Stupek, as applied to claims 5-8, and further in view of U.S. Patent No. 6,360,363 of Moser et al. ("Moser").

### *Status of Claims*

Claims 1-17 are pending in the application. Claims 2, 9, 10 have been amended to correct typographical errors. Claims 5-8 have been amended as to form. No claims have been added. No claims have been cancelled.

### *Claim Rejections - 35 U.S.C. §112 Second Paragraph*

Claims 1, 9 and 13 have been rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.

With regard to independent claim 1, the Office Action states: “Claim 1 recites the limitation ‘a method comprising’ in claim[sic]. There is insufficient antecedent basis for this limitation in the claim.” (Office Action, 1/4/05, p. 3). The Office action thus characterizes the preamble of claim 1 as a limitation, and further purports that the preamble requires an antecedent basis. Applicants respectfully submit that the rejection is improper on both counts.

Applicants submit that the preamble “A method comprising” is not a limitation. A “method” is statutory subject matter within the boundaries set forth in 35 USC §101 which permits patents to be granted for “any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof.” The term process, as defined in 35 USC §100 means process, art or **method**, and includes a new use of a known process, machine, manufacture, composition of matter, or material (MPEP 706.03(a)) (emphasis added).

The word “comprising” is a transitional phrase. In a method claim, the transition “comprising” indicates that the claim is open ended and allows for additional steps (MPEP 2111.03, citing *Invitrogen Corp. Biocrest Mfg., L.P.*, 327 F.3d 1364, 1368, 66 USPQ2d 1631, 1634 (Fed. Cir. 2003).

Applicants further submit that the preamble phrase “A method” is the proper form for an independent method claim, such as claim 1. Claim 1 does not rely on a prior claim, and therefore requires no antecedent basis.

Accordingly, applicants respectfully request that the rejection of claim 1 be withdrawn.

With regard to claim 9, the Office Action states: “Claim 9 recites the limitation ‘an apparatus for updating a message from a first version to an upgraded version by chaining through intermediate versions comprising’ in claim[sic]. There is insufficient antecedent basis for this limitation in the claim.” (Office Action, 1/4/05, p. 3). Here, the

Office Action broadly characterizes a claim preamble as a limitation, without identifying what the limitation might be, and asserts that the preamble of this independent apparatus claim requires an antecedent basis. Applicants submit that the rejection is improper on both counts.

Applicants first submit that the preamble “An apparatus for updating a message from a first version to an upgraded version by chaining through intermediate versions comprising” is not a limitation.

An “apparatus” is statutory subject matter within the boundaries set forth in 35 USC §101 which permits patents to be granted for “any new and useful process, **machine**, manufacture, or composition of matter, or any new and useful improvement thereof.” (emphasis added). The use of “apparatus” in lieu of “machine” is well-accepted claim drafting practice.

Applicants next direct the Examiner’s attention to MPEP 2111.02.

If the body of a claim fully and intrinsically sets forth all of the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed inventions limitations, then the preamble is not considered a limitation and is of no significance to claim construction.

(MPEP 2111.02, citing *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165 (Fed. Cir. 1999)).

Applicants submit that the body of claim 9 fully and intrinsically sets forth all of the limitations of the claimed invention, and that the phrase “for updating a message from a first version to an upgraded version by chaining through intermediate versions,” in the preamble of claim 9, is merely a statement reciting purpose or intended use. Therefore, it is not a limitation.

With respect to the term “comprising” in the preamble of claim 9, applicants refer the Examiner to the comments above regarding transitional phrases and submit that “comprising” does not constitute a limitation.

Applicants further submit that the preamble phrase “An apparatus” is the proper form for an independent apparatus claim, such as claim 9. Claim 9 does not rely on a prior claim, and therefore requires no antecedent basis.

Accordingly, applicants respectfully request that the rejection of claim 9 be withdrawn.

With regard to independent claim 13, the Office Action states: “Claim 12[sic] recites the limitation ‘an apparatus comprising’ in claim[sic]. There is insufficient antecedent basis for this limitation in the claim.” (Office Action, 1/4/05, p. 3). In view of the arguments above, applicants respectfully request that the rejection of claim 13 be withdrawn.

*Claim Rejections – 35 U.S.C. §101*

Claims 1, 9 and 12 have been rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. The Office Action states:

A claim that requires one or more acts to be performed defines a process. However, not all processes are statutory under 35 U.S.C. 101. Schrader, 22 F.3d at 296, 30 USPQ2.d at 1460. To be statutory, a claimed computer-related process must either: (A) result in a physical transformation outside the computer for which a practical application in the technological arts is either disclosed in the specification or would have been known to a skilled artisan, or (B) be limited to a practical application within the technological arts.(MPEP 2106 IV.B.2.(b))

Claims 1, 9 and 12, in view of the above cited MPEP section, are not statutory because they merely recite a number of computing steps without producing any tangible result and/or being limited to a practical application within the technological arts. The use of a computer has not been indicated.

(Office Action, 1/4/05, p. 4)

Applicants submit that the statements above are contradictory. In the first paragraph, the Office Action invokes a passage from the MPEP that discusses computer-related process claims. In the second paragraph, the Office Action recognizes that claims 1, 9 and 12 are not computer-related process claims because “the use of a computer has not been indicated.” If claims 1, 9 and 12 do not involve the use of a computer, as the Office Action states, how can the rejection be based on the requirements of a computer-related process?

Applicants respectfully submit that the Office Action misunderstands and misapplies the quoted passage from the MPEP. MPEP 2106 IV.B.2.(b) is directed at computer-related processes. Applying MPEP 2106 IV.B.2.(b) to claims 1, 9 and 12 is inapposite because claims 1, 9 and 12 are not computer-related process claims.

Claim 1 is a method claim reciting acts to be performed (i.e., updating, receiving, generating), not computing steps as the Office Action purports. As the Office Action states, the use of a computer has not been indicated. Applicants submit that claim 1 is a statutory process claim and respectfully request that the rejection of claim 1 be withdrawn.

Claim 9 is a “means plus function” apparatus claim, allowable under 35 U.S.C § 112 sixth paragraph, reciting means for performing acts (i.e., receiving, generating), not computing steps. Applicants submit that claim 1 is a statutory apparatus claim and respectfully request that the rejection of claim 9 be withdrawn.

Claim 12 is a dependent apparatus claim that depends from claim 9 and adds a limitation. In view of the above remarks with respect to claim 9, applicants submit that claim 12 is a statutory apparatus claim and respectfully request that the rejection of claim 12 be withdrawn.

*Claim Rejections – 35 U.S.C. §103(a)*

Claims 5-8 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Meyer in view of Stupek. It is submitted that claims 5-8 are patentable over the cited references.

Claim 5 recites:

An article of manufacture comprising a computer readable medium having instructions stored thereon, which when executed by a data processing system, causes the data-processing system to perform a method, comprising:  
receiving an update message having a first version format; and  
**generating repeatedly a revised update message having a next most recent version format based on the update message until a final update message having an upgraded version format is generated.**

(emphasis added)

The Office Action states, in part:

Meyer does not explicitly disclose repeated generation of a revised update message having a next most recent version format based on the update message until a final update message having an upgraded version format is generated. However, Stupek discloses a method for use in upgrading a resource of a computer from an existing version of the resource to a later version of the resource (see col. 1, lines 56 to col. 2, line 41). Further, in column 9, line 1 to column 10, line 6, Stupek discloses the upgrade installer builds the selected upgrade packages and installation instructions into a job, which is transferred into a staging area, an agent client is then notifies[sic] that a job has been placed in the staging area and the agent installs the packages in the job according to the installation instructions.

(Office Action, 1/4/05, pp. 5-6).

It is submitted that Stupek does not cure the deficiency of Meyer. Stupek teaches upgrading a program from an installed version to a newest version in one step, with no upgrades to versions between the installed version of the program and the newest version of the program. This is illustrated in Figure 9 of Stupek, which shows on the right hand side of box 51 the “Installed Version: 2.30” and the “Newest Version: 2.40 – 11/5/1993”

(Stupek, Fig. 9) (emphasis added). Thus, even if there was motivation to combine Meyer and Stupek (the Office Action provides none), the combined teachings of Meyer and Stupek would still be not include generating repeatedly a revised update message having a next most recent version format based on the update message until a final update message having an upgraded version format is generated.

The Office Action further states:

It would have been obvious to a person of ordinary [skill] in the art at [the] time the invention was made to modify the combined teachings of Meyer and Stupek with repeated generation of a revised update message having a next most recent version format based on the update message until a final update message having an upgraded version format is generated. Such modification would allow the teachings of Meyer to improve the accuracy of the method and apparatus for upgrading a database in a redundant environment by release chaining, and to provide automatically determined the availability of upgrades to resources on a computer system (see col. 2, lines 42-44).

(Office Action, 1/4/05, pp. 5-6).

The Office Action concedes that the combined teachings of Meyer and Stupek fail to teach or suggest the subject limitation, and seeks to invoke the motivation of one of ordinary skill in the art to modify the combined teachings of Meyer and Stupek. It is submitted that one of ordinary skill in the art would not be motivated to make such a modification. The object of the teachings of Meyer is to redeliver a stored message to a subscriber in a current format and do so in a manner that **speeds up the redelivery function**. (Meyer, col. 1, lines 35-40; col. 2, lines 35-47; col. 8, line 62). One of ordinary skill in the art, faced with the problem confronting Meyer, would not be motivated to repeatedly generate a revised update message having a next most recent version format because doing so would **slow down** the redelivery function, **contrary to the teachings of Meyer**. Therefore, it is respectfully submitted that claim 5 is patentable over the cited references.

Given that claims 6-8 depend from claim 5, it is submitted that claims 6-8 are also patentable over the cited references.

Claims 1-4 and 9-17 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Meyer in view of Stupek, as applied to claims 5-8 above, and further in view of Moser.

Claim 1 recites:

A method comprising:

**updating a message from a first version to an upgraded version by chaining through intermediate versions, wherein updating comprises:**  
receiving an update message having a first version format; and  
**repeatedly generating a revised update message having a next most recent version format based on the update message until a final update message having an upgraded version format is generated.**

(emphasis added)

Claim 9 recites:

An apparatus for updating a message from a first version to an upgraded version by chaining through intermediate versions comprising:

means for receiving an update message having a first version format;  
and[,]

means for **repeatedly generating a revised update message having a next most recent version format based on the update message until a final update message having an upgraded version format is generated.**

(emphasis added)

Claim 13 recites:

An apparatus comprising:

a network switching device to receive an update message having a first version format; and,

a controller card to **update a message from a first version to an upgraded version by chaining through intermediate versions, the controller card to repeatedly generate a revised update message having a next most**



**recent version format based on the update message until a final update message having an upgraded version format is generated.**

(emphasis added)

With respect to the limitation “repeatedly generating a revised update message having a next most recent version format based on the update message until a final update message having an upgraded version format is generated,” recited in claims 1, 9 and 13, applicants refer the Examiner to the comments above in respect of the same limitation in claim 5, and submit that Meyer and Stupek, alone or in combination, do not teach or suggest the subject limitation.

With respect to the limitation “updating a message from a first version to an upgraded version by chaining through intermediate versions,” recited in claims 1 and 13, the Office Action states, in part:

While Meyer and Stupek disclose the claimed subject matter except the claimed updating a message from a first version to an upgraded version by chaining through intermediate versions. However, Moser discloses an intermediate program P' that contains an intermediate version of each of the program modules to be upgraded, the intermediate version of a program module contains both the old version used in P and the new version used in P' (see Moser col. 3, lines 9-21).

(Office Action, 1/4/05, page 8)

Applicants submit that the Office Action mischaracterizes Moser. Moser teaches a method for upgrading a program by temporarily **combining** the old version of the program (P) and the new version of the program (P'') in **one** intermediate version of the program (P') (Moser, col. 3, lines 12-14). Moser does not teach “**chaining** through intermediate **versions.**” Thus, the combination of Meyer, Stupek and Moser fail to teach or suggest the subject limitation.

The Office Action further states:

It would have been obvious to a person of ordinary [skill] in the art at [the] time the invention was made to modify the combined teachings of Meyer, Stupek and Moser with updating a message from a first version to an upgraded version by chaining through intermediate versions. Such modification would allow the teachings of Meyer, Stupek and Moser to provide a mechanism that can upgrade a computer program without requiring that the normal operation of the computer program be suspended (see Moser col. 3, lines 32-36).

(Office Action, 1/4/05, page 8-9).

The Office Action concedes that the combined teachings of Meyer, Stupek and Moser fail to teach or suggest the subject limitation, and seeks to invoke the motivation of one of ordinary skill in the art to modify the combined teachings of Meyer, Stupek and Moser. It is submitted that one of ordinary skill in the art would not be motivated to make such a modification. As noted above, the object of the teachings of Meyer is to redeliver a stored message to a subscriber in a current format and do so in a manner that **speeds up the redelivery function**. (Meyer, col. 1, lines 35-40; col. 2, lines 35-47; col. 8, line 62). One of ordinary skill in the art, faced with the problem confronting Meyer, would not be motivated to update a message from a first version to an upgraded version by chaining through intermediate versions because doing so would **slow down** the redelivery function, **contrary to the teachings of Meyer**.

Therefore, in view of the foregoing arguments, applicants submit that claims 1, 9 and 13 are patentable over the cited references. Given that claims 2-4 depend from claim 1, that claims 10-12 depend from claim 9 and that claims 14-17 depend from claim 13, it is submitted that claims 2-4, 10-12 and 14-17 are also patentable over the cited references.

Applicants note that the Office Action repeats the rejections of claims 5-8 from the previous Office Action (mailed May 6, 2004), without addressing the applicants' remarks traversing the rejections in the response filed September 7, 2004.

The applicants respectfully direct the Examiner's attention to MPEP §707.07(f), which states, in part: "Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it." The examiner is respectfully requested to address all of the applicants' remarks traversing the rejections of claims 1-17.

In conclusion, applicants respectfully submit that in view of the arguments set forth herein, the applicable rejections have been overcome.

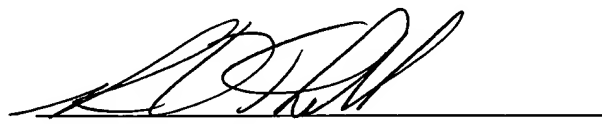
If the Examiner believes a telephone interview would expedite the prosecution of this application, the Examiner is invited to contact Richard Thill at (408) 720-8300.

If there are any additional charges, please charge our Deposit Account No. 02-2666.

Respectfully submitted,

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